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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,792	10/18/2001	Guillaume Royer	S1022/8246	9624

23628 7590 10/31/2002

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EXAMINER

LE, UYEN CHAU N

ART UNIT PAPER NUMBER

2876

DATE MAILED: 10/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/831,792

Applicant(s)

ROYER, GUILLAUME

Examiner

Uyen-Chau N. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Prelim. Amdt/Amendment*

1. Receipt is acknowledged of the Preliminary Amendment filed 18 October 2002.

### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### *Claim Objections*

4. Claims 1 and 7 is objected to because of the following informalities:

Re claim 1, line 4: Substitute "this slot" with -- the slot --.

Re claim 7, line 2: Substitute "the printing" with -- printing --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 3, line 1: "the etched surface" lacks antecedent basis.

Re claim 4, line 1: "the etched surface" lacks antecedent basis.

Re claim 5, line 1: "the etched surface" lacks antecedent basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orihara et al (US 5,705,852) in view of Fidalgo (US 5,671,525).

Re claims 1-6 and 8, Orihara et al discloses an electronic circuit including a planar base1, an antenna 2 attached on a first surface on the base1; and a chip 6 connected to the antenna 2 by connection wires 9 (figs. 5A & 5B), or by connecting bumps [6a, 6b] and connecting terminals [2a, 2b] followed by heating, which serves a welding beads; characterized in that a double faced adhesive 5 is glued on one of the base surfaces; and wherein the base 1 is formed of polyester film, which is flexible (fig. 1b; col. 3, lines 45+).

Orihara fails to teach or fairly suggest a slot being made in the double faced adhesive and the chip being arranged at least partially in the slot, and the chip and the wires being covered with a drop of resin.

Fidalgo teaches the above limitation with layer 4 having a cavity/slot 17 where an electronic module disposed the chip and the wires being protected with resin 14 (fig. 7; col. 4, lines 1+ and col. 5, lines 20-55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Fidalgo into the teachings of Orihara in order to provide Orihara with a more compact system, wherein by having the chip/electronic module disposed in a slot/cavity within the adhesive layer reduces the thickness of the card and reduces the amount of adhesive used therein, thus reducing the cost of manufacturing the IC card. Furthermore, such modification would provide Orihara with a better protection of the chip/IC module from the outside environment due to its hard resin. Accordingly, such modification would have been an obvious extension as taught by Orihara, and therefore an obvious expedient.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Orihara as modified by Fidalgo as applied to claim 1 above, and further in view of Hara et al (US 4,727,246). The teachings of Orihara as modified by Fidalgo have been discussed above.

Re claims 2 and 5, Orihara/Fidalgo disclosed the chip 6 connected to the antenna 2 by, but fails to teach or fairly suggest the surface of the base, which does not receive the double faced adhesive is provided to receive printing of a pattern of a text or of a code.

Hara et al teaches the above limitation with the surface of the base, which does not receive the double faced adhesive is provided to receive printing of a pattern of a code 41 (figs. 6 & 12; col. 8, lines 40+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hara et al into the teachings of Orihara/Fidalgo in order to provide Orihara/Fidalgo with a more secure system wherein each card has its unique identification code (e.g., a holder code, etc.). Furthermore, such modification would have been an obvious engineer design variations for aesthetic and security purposes, in which the card appearance is covered with pattern of a text, such as the holder's name and the service name, etc., thus the name of the card's holder can be recognized readily just by looking its cover, preventing fraudulent use in the event of lost/stolen/misplaced. Accordingly, such modification would have been an obvious extension as taught by Orihara/Fidalgo, and therefore an obvious expedient.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Haghiri-Tehrani et al (US 5,962,840); Mande (US 6,173,898); Fidalgo (US 5,598,032); Murohara (US 6,089,461); Iwasaki (US 5,612,532); Launay (EP 0,908,843); Dokochi et al (JP 09/030,169); Iohara (JP 2000,251,041); O'Malley et al (US 6,049,463); Orihara et al (JP 08/287,208); Kurachi et al (JP 10/315,668); Ochiai et al (JP 10/278,458);

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Takahashi (JP 11/034,563); Kuwamoto et al (JP 11/120,313); Ishizaka et al (JP 11/135,458); Kobayashi et al (JP 11/139,054) are cited as of interest and illustrate a similar structure to a self-adhesive electronic circuit.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M, W, F, SAT 6:00-11:00 and T, TH 8:30-7:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



*Uyen-Chau N. Le*

October 21, 2002



**MICHAEL G. LEE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**